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DAVID L WEINSTEIN COUNSEL ABBOTT LABORATORIES DEPT 377 AP6D/2 100 ABBOTT PARK ROAD ABBOTT PARK, IL 600646050			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 91703

Application Number: 09/363,728

Filing Date: July 29, 1999

Appellant(s): KRISHNASWAMY ET AL.

David L. Weinstein
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 30 June 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3, 5, and 6 stand or fall together and claim 4 is separated from claims 1-3, 5, and 6.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,507,288	Bocker et al	04/16/1996
5,074,977	Cheung et al	12/24/1991
5,052,943	David	10/01/1991
5,324,925	Koenck et al	06/28/1994
5,828,966	Davis et al	10/27/1998
5,307,263	Brown	04/26/1994
5,602,456	Cargin Jr. et al	02/11/1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Böcker et al (US 5,507,288) in view of Cheung et al (US 5,074,977); claims 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Böcker et al in view of Cargin, Jr. et al (US 5,602,456); claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5,052,943) in view of Koenck et al (US 5,324,925) and Davis et al (US 5,828,966); and claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,307,263) in view of Cheung et al (US 5,074,977). These rejections are set forth in prior Office Action, Paper No. 17 and duplicated as below.

Attention is directed to a typographical error in the Final Office Action (paper no. 17).

Claim 7 was inadvertent grouped with claim 3 (in paragraph 5). Claim 7 should have been taken out since it has been cancelled (in Applicant's Amendment, paper no. 16).

I. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Böcker et al (US 5,507,288) in view of Cheung et al (US 5,074,977).

Re claim 1, Böcker et al shows and discloses hand-held analytic test instrument comprising a housing (fig. 1); a barcode reader 28 disposed in the housing for scanning a barcode associated with a test strip 13 (fig. 1; col.6, lines 13+); a user interface comprising keypad 20 (e.g., on/off button) for activating/deactivating power and the barcode reader 28 (fig. 1; col. 5, lines 38-44); a port 17 for receiving the test strip 13 (fig. 1); an electronic circuit that is in electrical communication with the port 17 for processing an analytic signal received from the test strip 13 and generating analytic data therefrom (fig. 2; line 54 through col. 6, line 60); a display 21 is in electrical communication with the circuit for displaying certain analytical data (fig. 1; col. 5, lines 43-44); a connector in electrical communication with the circuitry and electrically connectable to a host computer via a data communications network, wherein the circuitry automatically uploads the analytical data to the host computer upon connection thereto (col. 8, lines 25+).

Böcker et al fails to teach or fairly suggest a numeric keypad for selecting test or menu modes, editing entries, terminating entries.

Cheung et al teaches a keypad 72 and display 24 of the measurement 10 allow operator inputs and information outputs to be effected (fig. 2; col. 10, lines 39-48).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the conventional keypad as taught by Cheung et al into the teachings of Böcker et al in order to provide the user with a more flexibility in selecting which test to perform and in inputting the necessary data. Furthermore, such modification would have

been an obvious extension as taught by Böcker et al, well within the ordinary skill in the art, and therefore an obvious expedient.

II. Claims 2 and 5-6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Böcker et al (US 5,507,288) in view of Cargin, Jr. et al (US 5,602,456 - cited by the applicant). The teachings of Böcker et al have been discussed above.

Re claims 2 and 5-6, Böcker et al shows and discloses hand-held analytic test instrument comprising a housing (fig. 1); a port 17 for receiving the test strip 13 (fig. 1); a barcode reader 28 disposed in the housing for scanning a barcode associated with a test strip 13 (fig. 1; col.6, lines 13+); a user interface comprising keypad 20 (e.g., on/off button) for activating/deactivating power and the barcode reader 28 (fig. 1; col. 5, lines 38-44); an electronic circuit that in electrical communication with the port 17 for processing an analytic signal received from the test strip 13 and generating analytic data there-from (fig. 2; line 54 through col. 6, line 60); a display 21 is in electrical communication with the circuit for displaying certain analytical data (fig. 1; col. 5, lines 43-44); a connector in electrical communication with the circuitry and electrically connectable to a power source 40 comprising a battery compartment, which is formed in the housing and inherently comprising a pair of electrical contacts for providing power from a battery to the electronic circuitry and a rechargeable battery disposed in a battery holder (fig. 2; col. 7, lines 4+).

Böcker et al fails to disclose or fairly suggest that the battery compartment also comprising a pair of recharge contacts; a bus bar and a user interface capable of allowing an operator to enter data, wherein the bus bar is disposed on the battery holder and in electrical communication with the pair of recharge contacts for recharging the batter when the instrument

is connected to the power source; and a numeric keypad for selecting test or menu modes, editing entries, terminating entries.

Cargin, Jr. et al teaches a battery compartment comprising contacts [34, 35], a bus bar 32 for recharging the battery directly without removing the battery out of the compartment 29, and for preventing the inadvertent and possibly hazardous application of recharging electrical power to non-chargeable batteries (col. 12, lines 42-46); and a user interface, which is keypad 14 having a plurality of keys 56 (fig. 1; col. 10, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cargin Jr. et al into the teachings of Böcker et al due to the fast, easy, and convenience way of recharging the battery directly without removing the battery out of the compartment. Furthermore, such modification would have provided Böcker et al with an alternative system allowing the user to enter the required data manually via the keypad. Accordingly, such modification would have been an obvious extension as taught by Böcker et al, well within ordinary skill in the art, and therefore an obvious expedient.

III. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5,052,943) in view of Koenck et al (US 5,324,925) and Davis et al (US 5,828,966).

Re claim 3, Davis shows and discloses a docking station 2 comprising a connector electrically 32 connectable to the instrument (fig. 1); a first data port in electrical communication being connectable to a computer for transferring data (see abs.1-4 and col. 5, lines 23-25); a second data port in electrical communication being connectable to a peripheral device for recharging the batteries (fig. 1; col. 5, lines 5-68, especially lines 22-23; and col. 10, lines 47-53); a control mechanism for controlling the switch, which is in electrical communication with

the connector, to selectively pass the analytical data to the computer or to the peripheral device (col. 5, lines 5-10; and col. 11, lines 24-30).

Davis fails to teach or fairly suggest that the docking station being configured to pass data between the analyte test instrument and the first data port when the docking station is in a default condition.

Koenck et al teaches this limitation in figs. 7-8 and col. 3, lines 28-37.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Koenck et al into the teachings of Böcker et al in order to provide Böcker et al with the latest technology, wherein data can be transmitted remote host terminal via wireless communication. Furthermore, such modification would have been an obvious extension as taught by Böcker et al, well within ordinary skill in the art, and therefore an obvious expedient.

Davis as modified by Koenck et al fails to teach or fairly suggest a circuitry to prevent overcharging.

Davis et al teaches a special feature to prevent overcharging (abs., lines 12-15 and col. 2, lines 6-10).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Davis et al into the teachings of Davis/Koenck et al in order to provide Davis/Koenck et al with a capability of preventing the system from being damaged by overcharging it. Furthermore, such modification would have been an obvious extension as taught by Davis/Koenck et al, well within the ordinary skill in the art, and therefore an obvious expedient.

IV. Claim 4 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,307,263) in view of Cheung et al (US 5,074,977). The teachings of Cheung et al have been discussed above.

Re claim 4, Brown teaches the method of managing data for a plurality of test instruments connected to a data communication network comprising step of: detecting via a host computer the connection of each instrument to the data communication network; uploading data receiving from each instrument to the host computer; processing the uploaded data on the host computer for operator review; and downloading configuration data from the host computer to each test instrument (figs. 1&2; col. 11, line 65 through col. 15, line 44; especially col. 12, lines 16-28).

Brown fails to teach or fairly suggest that each instrument including a test strip port, which accepts test strip for determining the level of analyte in a sample taken from a patient.

Cheung et al teaches the above limitation with a measurement 10 having a slot for accepting test strip 16 (fig. 2; col. 10, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cheung et al into the teachings of Brown in order to provide Brown with a high-tech system, wherein the reading results (i.e., level of analyte) of each analyte test can be directly transmitted to the host computer and the instruction for setting up and controlling of each analyte test can be received directly from the host computer. Furthermore, such modification would have provided Brown with a more compact system, wherein the data communication network system and the analyte test apparatus are in the same unit/instrument. Accordingly, such modification would have been an obvious extension as

taught by Brown to provide Brown with a more user-friendly system, wherein the user can have the analyte test result readily, well within ordinary skill in the art, and therefore an obvious expedient.

(11) Response to Argument

I. **ISSUE 1:** Appellant contends with respect to claim 1, which is directed to a hand-held analyte test instrument.

With respect to the Appellant's statement that "... claim 1 is anticipated (35U.S.C. § 102(b)) ..." (see page 7, lines 6+), the examiner has noted this typographical error, and accordingly the typographical error has been corrected in the Final Office Action (paper no. 17) (i.e., Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Böcker et al (US 5,507,288) in view of Cheung et al (US 5,074,977)).

Appellant's argument with respect to claim 1 that "Böcker et al and Cheung et al never recognized appellant's problem ... Böcker et al and Cheung et al are improperly combined because there is no suggestion ..." (see page 7, lines 20+) is not persuasive. Böcker et al discloses a hand-held analytic test instrument which includes a keypad 20 (e.g., on/off button) for operating the instrument by activating the power and/or the barcode reader per se, wherein the barcode reader 28 is disposed in the housing for scanning a barcode associated with a test strip 13. Cheung et al teaches a hand-held measuring instrument/analytic test instrument 12 that includes a numeric keypad 72 allowing the user to operate the instrument to perform analysis of signals from sensor element/test strip 16 (fig. 2; col. 3, lines 11+). Accordingly, one of ordinary skill in the art would have recognized the addition (i.e., incorporating the keypad which includes

the numerical keypad) as taught by Cheung et al into the teachings of Böcker et al in order to provide the operator of the Böcker et al's device with a more versatile and an additional capability for the operator to selectively select the necessary program(s) and the notes/comments via the keypad in the event the barcode reader malfunction.

II. ISSUE 2: Appellant contends with respect to claim 3, which is directed to a docking station for a hand-held analyte test instrument.

With respect to Appellant's argument that Koenck et al does not disclose the claim features of a docking station having a first data port being electrically connectable to a computer and a second data port being electrically connectable to a peripheral device (see page 9, lines 12-15), the examiner respectfully disagree. First, Koenck et al teaches a central processing unit, which serves as a computer, for processing/transmitting data (see col. 2, lines 47-51). Second, these claim features has been taught by Davis '943 (see the duplicate rejection above and Davis'943: abs.1-4; col. 5, lines 23-25; fig. 1; col. 5, lines 5-68, especially lines 22-23; and col. 10, lines 47-53), Davis '943 in view of Koenck et al only for the docking station being configured to pass data between the analyte test instrument and the first port when the docking station is in a default condition (see Koenck et al: col. 3, lines 28-38). Davis as modified by Koenck et al is silent with respect to the circuit that which prevents the overcharging of the peripheral device/terminal. Davis et al discloses charging cradle, which serves a docking station, that includes a circuitry to prevent the overcharging of the device (see Davis et al: abs., lines 12-15 and col. 2, lines 6-10). Accordingly, Davis as modified by Koenck et al and Davis et al meets the limitation of the claimed invention.

Appellant's argument with respect to claim 2 that "the combination of Davis '943, Koenck et al, and Davis et al '966 fails to disclose or suggest a docking station" that includes:

- 1) a first data port being electrically connectable to a computer,
- 2) a second data port being electrically connectable to a peripheral device, and
- 3) a docking station being configured to pass data between the analyte test

instrument and the first data port when the docking station is in a default condition.

First, Davis teaches a docking station 2 having a first data port (i.e., a first electrical communication element which is connected to a computer) for transferring data there-between (see abs.1-4 and col. 5, lines 23-25); and a second data port (i.e., a second electrical communication element which is connected to a peripheral device for recharging the batteries (fig. 1; col. 5, lines 5-68, especially lines 22-23; and col. 10, lines 47-53).

Second, with respect to the *passing data between the analyte test instrument and the first data port* when the docking station is in a *default condition*, Koenck et al teaches that in default condition, the data is transmitted and received between the hand-held terminal 10 and the docking station 34 including a plurality of docking ports 36. As discussed above, Koenck discloses a central processing unit for processing and transmitting data to the hand-held terminal 10 (see col. 2, lines 47-51), and the terminal 10 is placed on the docking station 34 for transmitting and receiving data (see col. 2, lines 47-51 and col. 3, lines 28-38); therefore the computer or central processing unit has to be connected to the docking station 34. Accordingly, given its broadest reasonable interpretation, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Koenck et al into the teachings of Davis in order to provide the latest technology system (i.e., the hardware

and the software) wherein the information/data is transmitted/received automatically between the terminal/hand-held instrument and the central computer when the docking station is in default condition; therefore, if the user does not wish to recharge the terminal's batteries, he/she does not have to operate any key and/or button, thus reducing labor and less time consumption system.

Finally, with respect to *a circuit to prevent overcharging*, Davis et al teaches a special feature to prevent overcharging (abs., lines 12-15 and col. 2, lines 6-10).

Accordingly, one of ordinary skill in the art would have recognized the additional features (i.e., incorporating the circuit to prevent overcharging of the terminal) as taught by Davis et al into the teachings of Davis/Koenck et al would provide Davis/Koenck et al with a reliable system/device that which would prevent the internal component(s) from being permanently damage, especially the battery.

III. ISSUE 3: Appellant contends with respect to claim 4, which is directed to a method of managing data for a plurality of analyte test instruments connected to a data communication network.

With respect to Appellant's argument that Cheung et al does not disclose or suggest the use of a console 12 in combination with a docking station (see page 10, lines 16-17), it is noted that this feature is not recited in the rejected claim 4. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to Appellant's argument that Brown does not disclose or suggest that the glucose monitor can be inserted into the hand held unit 12, ... (see page 10, lines 20-24), the examiner respectfully disagree and respectfully requests the Appellant to review Brown, wherein

monitors can be arranged in a variety of ways... or otherwise employed by handheld unit 12 (col. 8, lines 2-8).

With respect to Appellant's argument that there is no suggestion in Brown to arrange a network having a plurality of consoles plugged into a plurality of docking stations (see page 10, lines 24-25), it is noted that this feature is not recited in the rejected claim 4. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's argument with respect to claim 4 that the combination of Cheung et al and Brown fails to disclose or suggest a system that requires:

- 1) a plurality of analyte test instruments connected to a data communication network, and
- 2) each of the analyte test instruments of the plurality of analyte test instruments includes a test strip port.

First, Brown teaches a plurality of test instruments (i.e., hand held unit 12) connected to a data communication network (figs. 1&2; col. 11, line 65 through col. 15, line 44; especially col. 12, lines 16-28).

Second, with respect to *each of the analyte test instruments of the plurality of analyte test instruments includes a test strip port*, Cheung et al teaches a measurement 10 having a slot for accepting test strip 16 (fig. 2; col. 10, lines 24+).

Accordingly, one of ordinary skill in the art would have recognized the incorporation of the test strip as taught by Cheung et al into the instrument/terminal of Brown would provide a compact and portable system, wherein the data communication network system and the analyte

test apparatus are integrated into a single unit/instrument. Furthermore, such modification would provide Brown with the capability of giving/displaying the analyte test result readily to the operator, and thus providing a less time consumption system.

IV. ISSUE 4: Appellant contends with respect to claims 2 and 5-6, which representative of the grouped claims of claims 2 and 5-6, that is directed to a hand-held analyte test instrument.

With respect to Appellant's argument that neither Bocker nor Cargin Jr. et al disclose or suggest an analyte test instrument having both a user interface allowing an operator to enter data and a barcode reader disposed in the housing for scanning a barcode... (see page 11, lines 11-15), the examiner respectfully disagree and respectfully request the Appellant to review Cargin Jr. et al, wherein a hand-held data terminal 310 includes a user interface [14, 402] for allowing an operator to enter data and a laser scanner for scanning a barcode symbology (fig. 17; col. 22, line 51 through col. 12, line 16). Furthermore, Bocker teaches a unit 3 having a barcode reader 28 disposed within the housing for reading a barcode associated with the test strip 13 (fig. 1; col. 6, lines 13+).

Appellant's argument with respect to claim 2, the combination of Bocker and Cargin Jr. et al fails to disclose or suggest a system that requires:

- 1) a barcode reader disposed within the housing for reading a barcode associated with the test strip, and
- 2) a user interface allowing an operator to enter data .

First, Bocker teaches a unit 3 having a barcode reader 28 disposed within the housing for reading a barcode associated with the test strip 13 (fig. 1; col. 6, lines 13+).

Second, with respect to *a user interface allowing an operator to enter data*, Cargin Jr. et al teaches a hand-held data terminal 310 includes a user interface [14, 402] for allowing an operator to enter data and a laser scanner for scanning a barcode symbology (fig. 17; col. 22, line 51 through col. 12, line 16). Accordingly, one of ordinary skill in the art would have recognized the addition (i.e., incorporating the keypad which includes the numerical keypad) as taught by Cargin Jr. et al into the system of Bocker would provide the user an alternative means for entering the data (i.e., via the keypad) in the event the barcode system of the instrument malfunction.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Uyen-Chau N. Le
Uyen-Chau N. Le
October 29, 2003

The appeal brief filed by the appellant was reviewed by conference in the examining group on 17 September 2003. The conferees of the appeal conference were:

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